

REMARKS

This application has been carefully reviewed in light of the Office Action dated October 1, 2003. Claims 1-11 remain pending in this application. Claims 1 and 11 are the independent claims. Favorable reconsideration is respectfully requested.

On the merits, the Office Action rejected Claims 1-3 and 8-11 under 35 U.S.C. § 102(e) as being anticipated by Karasawa (U.S. Patent No. 6,091,740; hereinafter "Karasawa"). The Office Action also rejected Claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Karasawa in view of Kobayashi (U.S. Patent No. 4,694,453; hereinafter "Kobayashi"). Applicants respectfully traverse the above rejections for at least the following reasons.

Karasawa fails to recite or suggest the star node containing a plurality of star interfaces which are assigned to at least one network node and that one star interface controls the conveyance of a message from the assigned network node to the other star interfaces, or from another star interface to at least one of the assigned network nodes. Karasawa recites in Col. 3, lines 31-35 (emphasis added) that "(OSU) 2A is connected to a single star coupler 3, and provides interface functions..." Karasawa requires that interface functions occur within OSU 2A. Thus, even assuming arguendo that Karasawa recites star interfaces that couple the star

node to the network units, the star interfaces of Karasawa do not provide interface functions. All star coupler 3 does is, as Karasawa clearly recites in Col. 3, lines 41-42 recite (emphasis added): "[t]he star coupler 3 passively combines signals, referred to below as upstream signals, from the optical network units 1-1 to 1-N into a single upstream signal sent to the subscriber line terminal 2 and passively branches signals... from the subscriber line terminal 2 to all of the optical network units 1-1 to 1-N." Thus, Karasawa separates the star coupler 3 from any optical subscriber units and performs no interface functions (i.e., controlling conveyance of a message). This requires additional transmission of signal from the star coupler to OSU 2A.

In addition, the Office Action argues on page 7, that "star coupler, interfaces with the network units so it must have star interfaces that couple the star node to network units. Karasawa fail to recite or suggest that the star node contains a plurality of star interfaces which are assigned to at least one network node. Applicants respectfully note that a missing element is inherently present in a reference only if that element necessarily follows from what has been expressly described, and would be so recognized by one of skill in the art (as opposed to the examiner's expectation). Mere possibilities or even probabilities are not

enough; necessity recognized by those of skill in the art is required.<sup>1</sup> The M.P.E.P. echoes this case law.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

Further, the following is also emphasized:

In relying upon the theory or inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

M.P.E.P. § 2112 (emphasis in original) (citations omitted).

It is well established that a recited element or step is inherently present in a prior art reference only if that element is necessarily present or necessarily performed in that reference, and further that its presence or performance would be recognized by one of ordinary skill in the art from what has been expressly described. Second, the Office Action must provide objective

<sup>1</sup> The Federal Circuit has clearly set out the standard for inherency in, e.g., Continental Can Co. v. Monsanto Co., 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added):

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill. In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981) (quoting Hansgirc v. Kemmer, 40 U.S.P.Q. 665, 667 (C.C.P.A. 1939)) provides: "Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

This citation is also set out in M.P.E.P. § 2131.01(d).

evidence or cogent technical reasoning to support a contention of inherency.<sup>2</sup>

Simply because, as the Office Action alleges, Karasawa's star coupler is connected to network units, it is not satisfactory to support an inherency argument. Karasawa's star coupler may have star interfaces which are not assigned to at least one network node, but rather another star coupler, OSU, or other device.

Consequently, the rejection is traversed at least because Karasawa fails to recite or suggest every limitation of Applicants' Claim 1.

Claim 11 recites a network substantially corresponding to Claim 1 and is believed patentable for at least the same reasons. In addition, Karasawa fails to recite or suggest a pilot signal, but rather recites PDS headers coupled to the payload which are transmitted at the same time. Thus, the rejection is traversed at least because Karasawa fails to recite or suggest all the limitations of Applicants' Claim 11.

Claims 2-10 depend from one or another of the independent claims discussed above and are believed patentable for at least the same reasons. Applicants respectfully believe Claims 2-10 to be independently patentable and request separate consideration of each

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<sup>2</sup> "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

claim. Applicants further believe the § 103 rejections of Claims 4-6 to be moot in light of the above remarks and request their withdrawal.

In view of the foregoing amendments and remarks, Applicants respectfully submits that the currently-pending claims are clearly patentably distinguishable over the cited and applied references. Accordingly, entry of this amendment, reconsideration of the rejections of the claims over the references cited, and allowance of this application is earnestly solicited.

Respectfully submitted,

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